

United States Patent and Trademark Office

Examiner: Dexter, C.

Art Unit: 3724

Docket No. 3621

In re:

Applicant: FELDER, S., et al

Serial No.: 10/574,681

Filed: April 4, 2006

AMENDMENT

January 7, 2009

Commissioner for Patents
P O Box 1450
Alexandria, VA 22313-1450

Sirs:

Responsive to the Office Action of October 2, 2008, please amend
the application as follows:

In the specification:

Cancel lines 2-6 and substitute therefore:

CROSS-REFERENCE TO RELATED APPLICATION

The invention described and claimed hereinbelow is also described in German Patent Application DE 10 2004 063 174.3 filed on December 29, 2004. This German Patent Application, whose subject matter is incorporated here by reference, provides the basis for a claim of priority of invention under 35 U.S.C. 119(a)-(d).

BACKGROUND OF THE INVENTION

The present invention relates to a hand-held power tool with a barrel grip.

Page 1, cancel lines 21-24 and substitute therefore:

SUMMARY OF THE INVENTION

Accordingly, it is an object of the invention to provide a hand-held power tool, in particular a barrel grip jigsaw which is a further improvement of the existing hand-held power tools.

Page 5, cancel line 8 "Drawings".

Page 5, in line 15, insert:

BRIEF DESCRIPTION OF THE DRAWINGS

Page 6, cancel line 4 and substitute therefore:

DESCRIPTION OF THE PREFERRED EMBODIMENTS

In the claims:

1. (currently amended) A hand-held power tool, ~~in particular a barrel jigsaw, having comprising a housing,~~ a barrel grip (10), ~~characterized by means of a detachable top handle (12), which is embodied separately from said barrel grip,~~ and an attaching device (14) for attaching ~~the~~said top handle (12) ~~to said housing.~~

2. (currently amended) The hand-held power tool as recited in claim 1, wherein ~~the~~said fastening device (14) is provided for tool-free attachment and/or detachment of ~~the~~said top handle (12).

3. (currently amended) The hand-held power tool as recited in claim 1, wherein an on-off switch (18) is at least partially integrated into ~~the~~said top handle (12).

4. (currently amended) The hand-held power tool as recited in claim 3, wherein a locking mechanism (20) for locking ~~the~~said on-off switch (18) is integrated into ~~the~~said top handle (12).

5. (currently amended) ~~A~~The hand-held power tool ~~having a handle (12) and an on-off switch (18) at least partially integrated into the handle (12) and having a locking mechanism (20) for locking the on-off switch (18), in~~

particular—as recited in claim 4, wherein ~~the~~said locking mechanism (20) has at least two at least largely decoupled actuating elements (22, 24).

6. (currently amended) The hand-held power tool as recited in claim 5, wherein ~~the~~said actuating elements (22, 24) are situated on opposite sides of ~~the~~said top handle (12).

7. (currently amended) The hand-held power tool as recited in claim 3, wherein ~~the~~said fastening device (14) is at least partially integrally joined to a functional component of ~~the~~said on-off switch (18).

8. (currently amended) The hand-held power tool as recited in claim 7, wherein a holding mechanism of ~~the~~said fastening device (14) is integrally joined to an actuator rod guide.

9. (currently amended) The hand-held power tool as recited in claim 8, wherein ~~the~~said holding mechanism is comprised of a locking pin (26).

10. (currently amended) The hand-held power tool at least as recited in claim 3, wherein the on-off switch (18) at least partially integrated into the top handle (12) is at least in part integrally joined to ~~an~~ a second on-off switch (28) at least partially integrated into the barrel grip (10).

11. (currently amended) The hand-held power tool as recited in claim 1, wherein ~~the~~said top handle (12) is provided to constitute a support surface (30, 32) for ~~the~~a back of a hand.

12. (original) The hand-held power tool as recited in claim 11, wherein the support surface (32) is comprised of a soft elastic component (34).

13. (previously presented) A top handle (12) for a hand-held power tool as recited in claim 1.

14. (new) The hand-held power tool as recited in claim 1, wherein said top handle extends at least partially along said housing.

15. (new) The hand-held power tool as recited in claim 1, wherein said top handle is configured as an arc.

16. (new) The hand-held power tool as recited in claim 1, wherein said housing forms said barrel grip.

17. (new) The hand-held power tool as recited in claim 1, wherein said barrel grip is configured so that it is aligned with a working direction.

18. (new) The hand-held power tool as recited in claim 1, wherein said housing is configured as an L-shaped housing.

19. (new) The hand-held power tool as recited in claim 5, wherein said actuating elements are configured so that they are actuatable directly by a user.

20. (new) The hand-held power tool as recited in claim 5, wherein said actuating elements are comprised of separate components.

21. (new) The hand-held power tool as recited in claim 5, wherein said actuating elements are arranged to provide a device useable for left-handers and right-handers with same requirements.

22. (new) The hand-held power tool as recited in claim 8, wherein said locking pin is a part of a detent mechanism and is moveable in opposition to a spring.

23. (new) The hand-held power tool as recited in claim 8, wherein said locking pin is hollow and wherein said guide rod is guided inside said locking pin.

24. (new) The hand-held power tool as recited in claim 10, wherein said part which is integrally joined with said on-off switch of said top handle and with said second on-off switch of said barrel grip is configured as an electrical switch.

25. (new) The hand-held power tool as recited in claim 10, wherein a detent mechanism comprises a retaining tab which locks said second on-off switch when said top handle is attached to said housing.

26. (new) The hand-held power tool as recited in claim 11, wherein an open reach-through region is provided between the top handle and the barrel grip.

27. (new) A barrel jigsaw, comprising a housing, a barrel grip, a detachable top handle, which is configured separately from said barrel grip, and an attaching device for attaching said top handle to said housing.

28. (new) A hand-held power tool, comprising a handle, an on-off switch at least partially integrated into said handle, and a locking mechanism for locking said on-off switch, wherein said locking mechanism has at least two at least largely decoupled actuating elements.

29. (new) The hand-held power tool as recited in claim 29, wherein said actuating elements are situated on opposite sides of said handle.

30. (new) The hand-held power tool as recited in claim 29, wherein said actuating elements are comprised of separate components.

REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 1-3, 7-9, 11-13 are rejected under 35 USC 102(b) over the U.S. patent to Knouse et al.

Claims 4-6, 10 and 12 are rejected under 35 USC 103(a) over the patent to Knouse et al.

Also, the drawings are objected to and the claims are objected to and rejected under 35 USC 112.

In connection with the Examiner's formal objections and rejections, applicant submitted a drawing with a proposed corrected and amended the claims correspondingly. It is believed that the grounds for the formal objections and rejections should be considered as not tenable and should be withdrawn.

After carefully considering the Examiner's grounds for rejection of the claims, applicant amended the pending claims and submitted a new set of Claims 14-30.

The feature of new Claim 14 is shown in figures 1 to 3 and is disclosed on page 1, line 30 of the patent application.

The feature of new Claim 15 is shown in figures 1 to 3 and is disclosed on page 6, line 26 of the patent application.

The feature of new Claim 16 is shown in figures 1 to 3 of the patent application.

The feature of new Claim 17 is shown in figures 1 to 3 and is disclosed on page 2, line 3 of the patent application.

The feature of new Claim 18 is shown in figures 1 to 3 and is disclosed on page 6, line 8 of the patent application.

The feature of new Claim 19 is disclosed on page 2, lines 28 to 30 of the patent application.

The feature of new Claim 20 is shown in figures 4 and 7 and is disclosed on page 2, line 31 and on page 10, line 7 of the patent application.

The feature of new Claim 21 is shown in figure 4 and is disclosed on page 3, lines 5 to 9 of the patent application.

The feature of new Claim 22 is shown in figures 5 and 6 and is disclosed on page 3, lines 27 to 29 of the patent application.

The feature of new Claim 23 is shown in figures 5 and 6 and is disclosed on page 3, lines 27 to 29 of the patent application.

The feature of new Claim 24 is shown in figures 5 and 6 and is disclosed on page 9, lines 7 to 11 of the patent application.

The feature of new Claim 25 is shown in figures 5 and 6 and is disclosed on page 8, line 25 to page 9, line 2 of the patent application.

The feature of new Claim 26 is shown in figures 1 to 3 and is disclosed on page 4, lines 11 to 13 of the patent application.

The feature of new Claim 27 is disclosed in Claim 1.

The feature of new Claim 28 is disclosed in Claim 5.

The feature of new Claim 29 is disclosed in Claim 6.

The feature of new Claim 30 is shown in figures 4 and 7 and is disclosed on page 2, line 31 of the patent application.

It is respectfully submitted that the new features of the present invention which are now defined in Claim 1, the broadest claim on file, are not disclosed in the prior art applied by the Examiner.

The U.S. patent to Knouse discloses a portable power driven saw with a housing (A) and a handle (D) fastened to the housing (A) by means of screws (23). The handle (D) has two gripping portions which build a top hand grip (10) and a rear handle grip (12) (see Knouse, figure 1 and page 1, column 1, line 39 to column 2, line 20).

In contrast, the present patent application claims a hand-held power tool which comprises a housing (16), a barrel grip (10), a detachable top handle (12), which is embodied separately from the barrel grip (10), and an attaching device (14) for attaching the top handle (12) to the housing (16).

The Knouse patent does not disclose that the gripping portion which forms the rear handle (12) and the gripping portion which builds the top handle (10) are embodied separately from each other. Therefore, the present invention as defined in new Claim 1 is novel over the Knouse reference.

The original claims were rejected over this reference as being anticipated under 35 USC 102(b). As explained hereinabove, the patent to Knouse does not disclose the new features of the present invention as defined in amended Claim 1. In connection with this it is believed to be advisable to cite the decision In Re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the patent to Knouse does not disclose each and every element in the present invention as now defined in Claim 1, and therefore the anticipation rejection based on this reference should be considered as not tenable and should be withdrawn.

The patent to Knouse also does not provide any hint or suggestion for the new features of the present invention as defined in amended Claim 1. The patent to Knouse teaches to integrate two differently oriented gripping portions or hand grips (10, 12), respectively, in one handle (D) (see Knouse, figure 1 and page 1, column 1, lines 52 to 55).

Contrary to the teaching of Knouse is the approach of amended Claim 1 of the present patent application, which claims to embody a detachable top handle (12), separately from a barrel grip (10). Thus, a user can choose a

configuration of the hand-held power tool which fits his needs best, e.g. he can remove the detachable top handle (12) in case of a hindrance due to the detached top handle (12) during a work process and therefore has a hand-held power tool which could be operated with the barrel grip (10) and thus is compact and handy in use.

Since the patent to Knouse does not disclose to embody the top hand grip (10) separately to the rear hand grip (12) it could not be seen from which feature out of the Knouse reference a person skilled in the art should have obtained at the time the invention was made any hint to construct the hand grips as defined in present Claim 1. Moreover, since the Knouse patent chooses the integrally formed hand grips (10, 12) in the handle (D) purposefully and especially points out that due to a handle with duplex grips the advantages of two structures can be combined beneficially in one structure (see Knouse, page 2, column 2, lines 35 to 40), a person skilled in the art would not have obtained any encouragement or motivation at the time the invention was made to change the construction of the handle (D) or to embody the top hand grip (10) and the rear hand grip (12) as separate parts, respectively. Therefore, the teaching of the Knouse reference and that of the patent application are contradictory towards each other and the invention as defined in the amended Claim 1 is unobvious, inventive and patentable over the Knouse reference.

It is believed to be clear that it cannot be considered as obvious to arrive at the present invention as defined in amended Claim 1 from the teaching of the patent to Knouse. In order to arrive at the present invention from the teaching of this reference, the reference has to be fundamentally modified, and in particular by including into it the new features of the present invention which are now defined in amended Claim 1. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

It is therefore believed that the present invention as defined in Claim 1 cannot be considered as obvious from the teaching of the reference applied by the Examiner against the original claims.

The Examiner's attention is also respectfully directed to the features of some dependent claims. Referring to Claim 2, the Knouse patent does not show that the handle (D) could be attached tool-free.

In respect to Claims 7 to 9 the Knouse patent does not disclose that the fastening device (23) has a holding mechanism, which is embodied as locking pin and which is at least partially integrally joined to a functional component that is embodied as an actuator rod guide of the on-off switch (30, 32). Moreover, in view of new Claims 22 and 23, the Knouse patent discloses no locking pin of the fastening device (23) which is a part of a detent mechanism and is moveable in opposition to a spring and which is hollow. In addition, the Knouse patent does not disclose, that a guide rod is guided inside a locking pin.

Regarding new Claims 16 and 18, the Knouse patent does not disclose that the housing (A) forms the hand grip (10, 12) or is L-shaped.

Referring to new Claim 25, the Knouse patent discloses no detent mechanism which comprises a retaining tab that locks the on-off switch (30, 32) when the handle (D) is attached to the housing (A).

Additionally, the Knouse patent discloses no barrel jigsaw as claimed in new Claim 27.

Further, the Knouse patent does not disclose any inventive feature of the present Claims 4-6, 10, 12, as well as of the new Claims 19, 20, 21, 24 and 27-30.

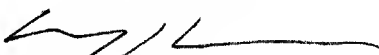
It is therefore respectfully submitted that it could not be seen in which feature a person skilled in the art would have obtained any motivation which would have led him to the inventive ideas of the Claims 2 to 30. As a result, all these claims should be considered as new and inventive over the Knouse reference.

In view of the above presented remarks and amendments, it is respectfully submitted that the present invention should be considered as patentably distinguishing over the art and should be allowed.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Striker', written over a horizontal line.

Michael J. Striker
Attorney for Applicant
Reg. No. 27233

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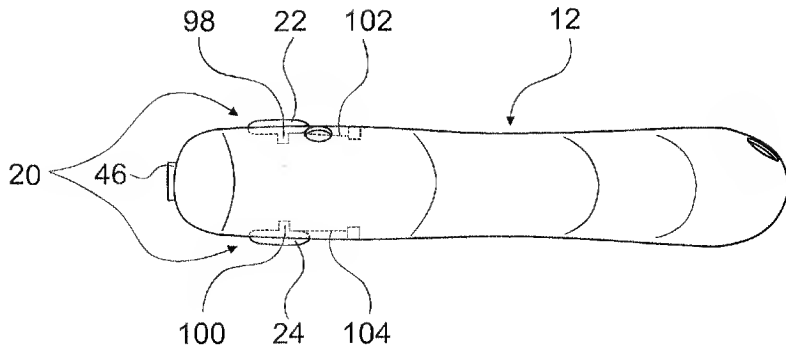


Fig. 4

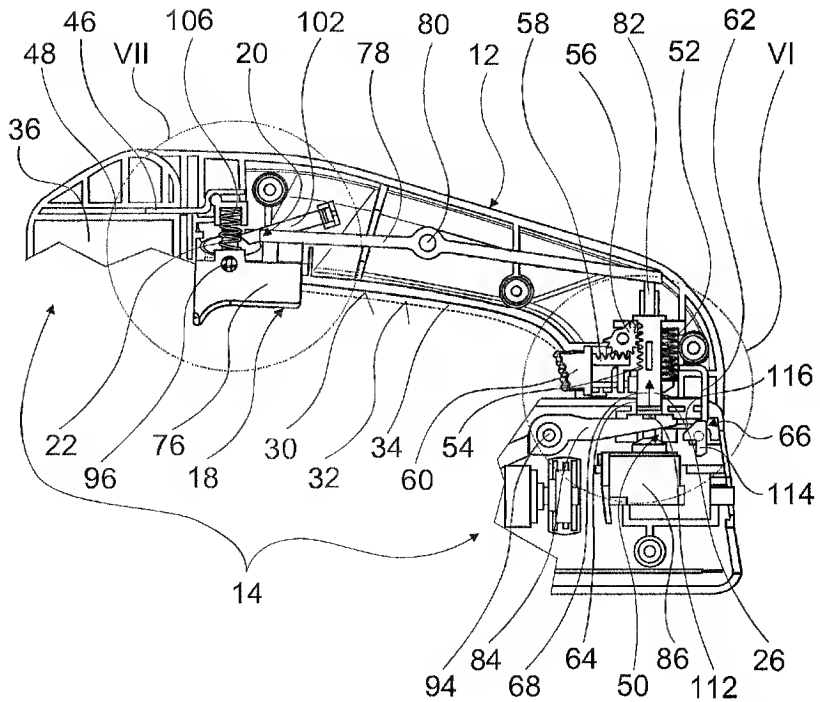


Fig. 5